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DAVENPORT EXAMINER

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ART. UNIT	PAPER NUMBER
1654	

03/03/98

DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on 12/11/97 This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice of Draftsman's Patent Drawing Review, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474.
6.

Part II SUMMARY OF ACTION

1. Claims 1-3, 5-8, 10-33 are pending in the application.
Of the above, claims 1-3, 5-8, 11-17, 22-23 and 25-33 are withdrawn from consideration.
2. Claims 4-10 have been cancelled.
3. Claims 1-3, 5, 6, 10, 18-21 and 24 are allowed.
4. Claims 25-33 are rejected.
5. Claims _____ are objected to.
6. Claims 25-33 are subject to restriction or election requirement.
7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. Formal drawings are required in response to this Office action.
9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).
11. The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).
12. Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____.
13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. Other

EXAMINER'S ACTION

Art Unit: 1654

Since this application is eligible for the transitional procedure of 37 CAR 1.129(a), and the fee set forth in 37 CAR 1.17(r) has been timely paid, the finality of the previous Office action is hereby withdrawn pursuant to 37 CAR 1.129(a). Applicant's second submission after final filed on December 11, 1997 has been entered.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3, 5-8, and 10-24 are pending in the instant application. Said claims have been amended as requested by applicants in the communication filed December 11, 1997. New claims 25-33, have been thoroughly considered and are deemed to bring up the issue of new matter. Applicants are requested to be more specific in pointing out where the claims find support in the originally presented specification. The information set forth on the second page of the remarks was not deemed convincing.

Claims 25-33 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims

Art Unit: 1654

present issues which are considered new matter. For example, there was no support pointed out for a peptide reagent with the formulas selected, and D-isomers thereof. See claim 26. Please specifically point out the support. There is no support for the method of labeling a peptide comprising the steps as set forth, see claim 27, wherein there is no mention of a reducing agent. The original claims and method all include the step of reacting the reagent in the presence of a reducing agent. Also the method for visualizing a site within a mammalian body, claim 32, was not found in the original specification.

The claims are deemed new matter, However, even if the claims are declared supported by the original specification, said claims are subject to restriction by original presentation.

Newly submitted claims 25-33 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3, 5,6, 10, 18-21 and 24, drawn to a reagent for preparing a scintigraphic imaging agent, classified in class 530, subclass 330. (See original restriction requirement as set forth in paper #7, filed

February 22, 1996.)

Art Unit: 1654

III. Claims 15, 16 and 27-31, drawn to a method of labeling a reagent , classified in class 424, subclass 1.11. (An addition to group III of the original restriction.)

IV. Claims 17 and 32-33 , drawn to a method of imaging and visualizing, classified in class 424, subclass 9.1. (An addition to group IV of the original restriction.)

VI. Claims 25-26, drawn to a peptide reagent, classified in class 530, subclass 330.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 25-33 are withdrawn from consideration as being directed to a non-elected invention. See 37 CAR 1.142(b) and MPEP § 821.03.

The REQUEST FOR INTERFERENCE filed December 11, 1997 has been thoroughly reviewed. The interference as set forth is drawn to claims 25-33. Said claims are subject to a new matter rejection and a restriction requirement. The

Art Unit: 1654

claims, if deemed supported by the original specification, should be presented in a divisional application for further consideration of the claims and the interference.

Claims 1-3, 5, 6, 10, 18-21 and 24 are in condition for allowance.

This application is in condition for allowance except for the presence of claims 7, 8, 11-17, 22-23 and 25-33 non-elected with traverse.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Avis Davenport whose telephone number is (703) 308-4002. The examiner can normally be reached on Tuesday-Friday from 8:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Cecilia Tsang, can be reached on (703) 308-0254. The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Art Unit: 1654

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Avis M. Davenport
AVIS M. DAVENPORT
PRIMARY EXAMINER
GROUP 1800/1654